

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:
Gentz et al.

Docket No.: PF454P1

Application Serial No.: 09/518,931-Conf. #7173

Art Unit: 1646

Filed: March 3, 2000

Examiner: E. B. O'Hara

Title: Tumor Necrosis Factor Receptor 6 Alpha &
6 Beta

**APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b) AND REQUEST TO AMEND ENTRIES IN PAIR**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request reconsideration of the Patent Term Adjustment indicated on the Notice of Allowance mailed on July 12, 2005 for the present application. Applicants believe the correct Patent Term Adjustment is 1020, not 1226 days. This request is being timely made, as it is submitted after the Notice of Allowance was mailed and not later than the payment of the issue fee. The requirements of 37 C.F.R. § 1.705(b)(1) are satisfied by the authorization for payment of the fee set forth in 37 C.F.R. 1.18(e) submitted herewith. The requirements of 37 C.F.R. § 1.705(b)(2) are satisfied by the following Statement of Facts.

STATEMENT OF FACTS

1. The following reviews the total periods of both Patent Office (PTO) Examination Delay calculated under 37 C.F.R. § 1.703 (a) through (e), Applicant delay calculated under 37 C.F.R. § 1.704(b)-(e), and the final determination of Patent Term adjustment under 37 CFR § 1.704(a). Briefly, Applicants believe the correct amount of PTO delay is 1146 days, the correct amount of Applicant delay is 126 days and that, therefore, the correct amount of Patent Term Adjustment is 1020 days. Applicants' reasoning for this determination is described in more detail below.

Period of Adjustment of Patent Term due to Examination Delay under 37 C.F.R. § 1.703 (a) through (e).

2. The Patent Office calculated two periods of Patent Office Delay:

- I. A delay of 1146 days PTO which corresponds to a delay under 37 C.F.R. § 1.703(a)(3) for the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.
- II. A delay of 206 days for the number of days in the period the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application (37 C.F.R. § 1.703(c)(2)).

Applicants agree with the PTO's calculations for item I above. As stated above, PTO delay under 37 C.F.R. § 1.703(a)(3) is calculated as the number of days in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. Applicants' Amendment after Final Rejection mailed on November 20, 2001 qualifies as a reply in compliance with § 1.113(c). The PTO's response to this paper was mailed May, 9, 2005. Thus, the period of PTO delay calculated with respect to these actions should be the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed, or March 20, 2002, and ending on the date of mailing of either an action under 35 U.S.C. 132, or May 9, 2005. The number of days between March 20, 2002 and May 9, 2005 is 1146 days, in agreement with the PTO's calculation for item I above.

3. Applicants disagree with the PTO's calculation of 206 days of PTO delay described under item II above. Applicants submit the correct amount for item II is 0 days. Applicants note that this period of 206 days extending from July 17, 2003 until February 8, 2004, overlaps entirely with the period calculated under item I above. Because this period is an overlapping period, no additional PTO delay should be assigned (see, 37 C.F.R. § 1.703(f)).

4. In view of the foregoing, the correct Period of Adjustment of Patent Term due to Examination Delay under 37 C.F.R. § 1.703 (a) through (e) is equal to the delay described in item I above, or 1146 days.

Reduction of Period of Adjustment of Patent Term under 37 C.F.R. § 1.704(b)-(e)

A. Patent Office Calculations for Applicant Delay

5. The Patent Office calculated four periods of Applicant Delay for failure to engage in reasonable efforts to conclude the processing or examination of an application under the following circumstances listed below. The periods of Applicant delay described below are numbered III-VI to avoid confusion with the periods of PTO delay described in items I and II above.

- III. A delay of 34 days for the period of time that was in excess of three months that was taken to reply to the Final Rejection mailed July 17, 2001. (37 C.F.R. § 1.704(b))
- IV. A delay of 63 days for the period of time that was in excess of three months that was taken to reply to the Non Final Rejection mailed May 9, 2005. (37 C.F.R. § 1.704(b))
- V. A delay of 28 days for submission of a reply having an omission on October 11, 2005 that was corrected with Applicants submission on November 8, 2005. (37 C.F.R. § 1.704(c)(7))
- VI. A delay of 1 day for the period of time that was in excess of three months that was taken to reply to the Non Final Rejection mailed January 24, 2006. (37 C.F.R. § 1.704(b))

Applicants agree with the PTO's calculations for item III-VI above. Accordingly, the total period of reduction of Patent Term adjustment as calculated under 37 C.F.R. § 1.704(b)-(e) is $34 + 63 + 28 + 1$ days, or 126 days of Applicant delay. This sum is in agreement with the PTO's calculations.

B. Inaccuracy in PAIR

6. PAIR indicates that on January 17, 2002, a letter suspending prosecution at *Applicant's request* was mailed. While a letter suspending prosecution was mailed that day,

Applicants did not request the suspension. This inaccuracy is brought to the attention to the Patent Office because if Applicants had indeed requested a suspension of prosecution, the period of Applicant initiated suspension would be an additional period of Applicant delay under 37 C.F.R. § 1.704(c)(1). As described below, the suspension of prosecution commencing on January 16, 2002 and ending on November 18, 2002 was initiated by the PTO and not Applicants.

7. A review of the file history of the present application shows that there is no Applicant initiated request for suspension in the file history, much less prior to January 17, 2002. As further evidence that the suspension commencing on January 17, 2002 in the present case was not Applicant initiated, Applicants note that a request for suspension of prosecution 37 CFR § 1.103 must be accompanied by a fee. Applicants are unable to ascertain that any such fee was paid out from Applicants deposit account, which is the Applicant's standard mode of paying patent prosecution fees to the PTO. Thus, Applicants submit that the letter of suspension mailed January 17, 2002 was initiated by the PTO.

8. Accordingly, Applicants request that the January 16 and 17, 2002 entries in PAIR for the present application be amended to delete "Applicant Initiated" and "at Applicant Request", respectively. Moreover, because the suspension commencing on January 16, 2002 and ending on November 18, 2002 was initiated by the PTO, there is no additional period of Applicant Delay that must be accounted for, other than those described in items III-VI, above.

Patent Term Adjustment

9. Pursuant to 37 CFR § 1.704(a) the final Patent Term Adjustment is the total period of adjustment of the term of a patent under § 1.703(a) through (e), or 1146 days (see paragraphs 2-4, above) less the period of time during which the Applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application as defined in § 1.704(b) - (e), or 126 days (see paragraphs 5-8, above). Using this calculation the total Patent Term Adjustment for the present application as of the payment of the issue fee would be 1146 -126 days, or 1020 days.

10. Other than the periods described above, Applicants do not believe there were any additional circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the present application as set forth in 37 C.F.R. § 1.704.

Statement Regarding Terminal Disclaimer

11. The above-identified application is not subject to a terminal disclaimer.

CONCLUSION

Applicants respectfully request that the patent term adjustment for the instant application be reconsidered in light of the facts and circumstances described above. In particular, Applicants maintain that the instant application is entitled to 1020 days of patent term adjustment.

In the event of a favorable decision based on this application, Applicants further request reimbursement of the fee which has been paid pursuant to 37 CFR § 1.18(e) for the present request, since payment of such fee was necessitated by a mistake of the Patent and Trademark Office.

If any further information is required, please call the undersigned at the number listed below. Please charge any additional fees due in connection with the filing of this paper, or credit any overpayment, to Deposit Account No. 08-3425.

Dated: October 11, 2006

Respectfully submitted,

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